

REMARKS/ARGUMENTS

Claims 1 and 2-8 and 10-23 are active in this case. Support for the definition of R_c in Claim 1 is found in Claim 2 (now cancelled). Support for new claims 11-23 is found in the specification in paragraphs [0015], [0016], [0017] and [0021].

No new matter is believed to have been added by the presentation of these claims

Applicants affirm the election of Claims 1-3, 7, 9 and 10 with R_b as a pyridine in view of the Examiner's Restriction requirement. However, Applicants request reconsideration of the restriction between at least groups I and II where R_b is a pyridyl or a phenyl because as defined herein, the claimed 1,2,4-triazole does define an inventive concept patentable over the prior art of record because as discussed below, the triazole compounds claimed, e.g., in claim 1, are particularly useful intermediates for production processes giving high yields with excellent efficiency, for example in producing the compounds as described in the '816 Nakamura patent, of record.

In addition, Applicants ask for consideration of rejoinder of the non-elected process claims upon finding that the elected claims are allowable (MPEP 821.04). Further, it should be noted that the claims as amended herein are not the same as the compounds patented in US 7,074,816. Rather, as stated in the specification on page 3, the invention is directed to the discovery of particularly useful processes for preparing the triazole compounds (such as those in the '816 patent) and the intermediates used for these processes. The intermediates are that which is claimed here.

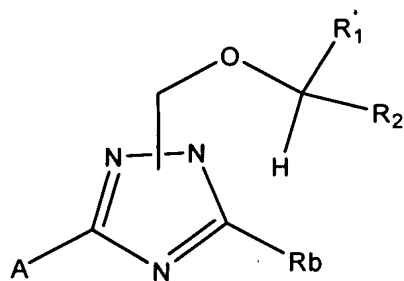
In the Official Action, the Examiner has rejected the claims based on the apparent overlap between the disclosures in U.S. patent no. 7,074,816 (Nakamura), Okamoto et al (2004 PNAS), U.S. patent no. 3,963,731 (Novello), and Browne (Chemical Abstract

1976:59317). The Examiner also rejects the claims as claiming obvious subject matter compared to certain claims of the Nakamura patent.

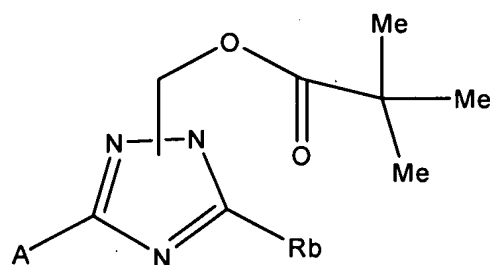
Nakamura has been applied to Claims 1 and 7 as originally presented. However, as discussed above and as apparent from the claims, Claims 1 and 7 have been amended in a manner to define Rc in a manner as previously set forth in Claim 2 and 9. Accordingly, this rejection is not applicable to the amended claims.

Similarly, Okamoto, Novello, and Browne were applied to only Claim 1 as originally presented. As Claim 2, defining Rc, has been incorporated into Claim 1, this rejection is not applicable to the amended claims.

To the obviousness rejection based on Nakuma (presumably Nakamura's '816 patent), Applicants request reconsideration of this rejection. While the claimed triazole has some similarity to the compounds in Nakamura, it cannot be concluded that the present claims would have been obvious. For one, the structures are different now that Claim 2 has been included in the definition of the triazole in Claim 1, for example. Second, the case law makes it quite clear that "Where an invention for which a patent is sought is a compound which is a member of an homologous series and the prior art discloses a *nonadjacent* member of that series, we do not consider the Hass and Henze cases authority for the legal presumption of obviousness of the claimed invention." *In re Elperin*, 326 F.2d. 762, 140 USPQ 224 (CCPA 1964). For immediate comparison, the triazole claimed here and that in the '816 patent's Example 14 is below:



Example of the claimed triazole



Ex. 14 of US '816

Third, as explained in the specification, e.g., on page 3, the claimed intermediate triazole compounds have a unique utility in allowing the production of 1,2,4-triazoles can be obtained at an extremely high yield without requiring isolation in each step. This efficiency of this process using such intermediate triazoles is shown in the Examples, which is not at all suggested by the Nakamura '816 patent.

Accordingly, withdrawal of this rejection is requested.

Finally, the Examiner has rejected the claims under 112, second paragraph or under 35 USC 112, first paragraph based on the inclusion of the phrases "substituted," "optionally," "R_c represents . . . removed by acid," and others in Claim 7. This rejection should be rendered inapplicable in light of the definitions for R_c, the removal of optionally and the inclusion of claims defining substituents. Recognizing that certain claims continue to use "substituted or unsubstituted," it is submitted that based on this field and the disclosure of representative substituents to provide where indicated, the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity such that one in this field would know what is and what is not encompassed by the claims. For example, looking at R_b one knows whether substituted or not, it should at least include pyridyl or phenyl.

Accordingly, withdrawal of this rejection is requested.

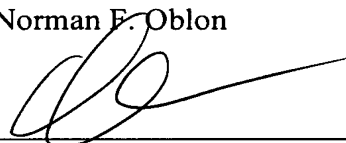
To the obviousness-type double patenting rejection in view of the claims of Nakamura's '816 patent, this rejection should be no longer applicable. As noted above and as apparent from the claims, the claimed triazole compounds differ significantly from those in the claims of the '816 patent in that they are particularly useful as intermediates for producing, e.g., the compounds in the '816 Nakamura patent with distinct advantages in terms of processing that are not suggested in the prior patent.

Accordingly, withdrawal of this rejection is requested.

Finally, a Notice of Allowance is requested for all pending claims.

Respectfully submitted,

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